



18 MAY 2006

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Bozicevic Field & Francis
1900 University Avenue
Suite 200
East Palo Alto CA 94303

Li-Hsien (Lily) Rin-Laures
Marshall, Gerstein & Borun LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 6060-6357

In re Application of CRAGER et al
Application No.: 10/525,583
PCT No.: PCT/US03/26388
Int. Filing: 21 August 2003
Priority Date: 27 August 2002
Attorney Docket No.: INTM-016
For: METHODS OF TREATING
IDIOPATHIC PULMONARY FIBROSIS

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: DECISION ON
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: PETITION
:
: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 17 January 2006, to accept the application without the signature of joint inventor, Scott Harkonen.

BACKGROUND

On 23 February 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 09 June 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 17 January 2006, applicant filed a Petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Scott Harkonen, alleging that Mr. Harkonen refuses to sign the appropriate forms.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant provided the requisite petition fee of \$200, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Scott Harkonen, was provided. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

Applicant attempted to satisfy Item (2) with the submission of the statement of facts in the petition under 37 CFR 1.47(a) from Paula A. Borden, attorney for applicant. Ms. Borden states that "Scott Harkonen's conduct constitutes a constructive refusal to sign". Ms. Borden states that applicant, InterMune, Inc. provided a copy of the application as filed to the inventors, including Scott Harkonen, as was their usual practice. However, Ms. Borden does not provide a first-hand statement from the person who provided a copy of the application to Mr. Harkonen to demonstrate that such was provided to the nonsigning inventor. Furthermore, the letters dated 29 April, 17 October and 2 December 2005 were attached do not indicate that a copy of the application (including specification, claims and drawings) was enclosed and sent to Mr. Harkonen. Ms. Borden's letter to Mr. Harkonen states that the only enclosures were the Declaration and Assignment.

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In sum, petitioner has not demonstrated: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/525,583 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Harkonen's refusal to sign, either in writing or by telephone, these documents.

The evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

Request to Withdraw as Attorneys of Record

The criteria for effecting a proper withdrawal of attorney are spelled out in Section 402.06

of the Manual of Patent Examining Procedure (MPEP) which reads, in part, as follows:

In the event that a notice of withdrawal is filed by an attorney or agent of record... appropriate procedure will be followed pertaining to the withdrawal. The **withdrawal is effective when approved** rather than when received.

To expedite the handling of requests for permission to withdraw as attorney, under 37 CFR 1.36(b), Form/SB/83 may be used. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of himself or herself and another....

The Director of the United States Patent and Trademark Office usually requires that there be at least 30 days between *approval* of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). This is so that the applicant will have sufficient time to obtain other representation or take other action.

Since all of the criteria delineated in Section 402.06 of the M.P.E.P. have been complied with and since there are no outstanding responses due, the request to withdraw as attorney of record is **GRANTED** and is effective as of the mail date of this communication.

All future communications will be forwarded to Li-Hsien (Lily) Rin-Laures, Marshall, Gerstein & Borun, LLP at the address listed on this communication.

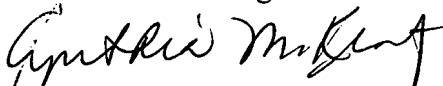
CONCLUSION

In view of the above discussion, counsel's Request for Withdrawal is **GRANTED**. The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

This application is being forwarded to the United States Designated/Elected Office for further processing.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286

Application No.: 10/525,583

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Facsimile (571) 272-0459